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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,425	07/05/2001	John J. Larkin	NPA 2 0002	3355
7590	01/18/2006		EXAMINER GOTTSCALK, MARTIN A	
Patrick R. Roche Fay, Sharpe, Fagan, Minnich & McKee, LLP 1100 Superior Avenue, 7th Floor Cleveland, OH 44114-2518			ART UNIT 3626	
DATE MAILED: 01/18/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/899,425

Applicant(s)

LARKIN

Examiner

Martin A. Gottschalk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-27 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, and 4-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Iliff (US Pat# 5,594,638).

- A. As per claim 1, Iliff discloses a case management method for managing a worker injury claim, comprising:

maintaining a database of suggested treatment plans (Iliff: col 55, section titled "XVII. Treatment Table");

recording a first report of injury (FROI) date (Iliff: col 55, lns 27-32, note the centrality of medical history; col 35, section titled "X. Evalation Process", in particular, lns 43-48. The Examiner considers the evaluation process to be a form of recording a

first report of injury. Note that one possible cause of a patient's problem is "trauma", i.e. an injury.);

identifying an injured body part (Iliff: col 35, lns 10-32);

obtaining an injury diagnosis (Iliff: Fig. 7d, item 344 and 254; col 34, section titled "X. Evaluation Process", i.e. the purpose of this process is to obtain a diagnosis);

assigning an injury classification code based on the obtained diagnosis and the identified injured body part (Iliff: col 12, lns 21-28);

receiving an associated job code (Iliff: col 12, lns 29-44, reads on "E-Codes" and "V-Codes". The Examiner considers that codes defining "...environmental events, circumstances, and conditions as the cause of injury..." and "...personal...history, and exposure to toxic chemicals," are forms of job codes to the extent that a patient's job is the environment, circumstance, or personal history relevant to the patient's condition.);

identifying a degree of disability management (DoDM) code based on the injury classification code and the associated job code (Iliff: col 52, section titled "XVI. Symptom Severity Analysis"; col 54, lns 37-43. The Examiner considers the calculated slopes to be a form of degree of disability management code based on the codes previously referenced.); and providing a treatment plan based on the diagnosis, said

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treatment plan being extracted from the database of treatment plans (Iliff: col 55, section titled "XVII. Treatment Table", Table 8 in particular.).

B. As per claim 2, Iliff discloses the case management method according to claim 1, wherein the step of assigning an injury classification code includes

assigning an ICD-9 code (Iliff: col 12, lns 21-28).

C. As per claim 4, Iliff discloses the case management method according to claim 1, wherein the step of identifying a DoDM code includes:

identifying a loosely managed benchmark code; and identifying a well managed benchmark code (Iliff: col 52, section titled "XVI. Symptom Severity Analysis"; col 54, lns 30-43. The Examiner considers that if a relatively few –say three or less- consultations have been performed, the resulting slope calculation is a type of loosely managed benchmark code. If "...beyond three consultations are desired...to establish a trend with certainty..." are performed, the Examiner considers the resulting slope calculation to be a type of a well managed benchmark code).

D. As per claim 5, Iliff discloses the case management method according to claim 4, wherein the step of identifying a loosely managed benchmark code includes:

identifying a statistical average period between injury and return to work corresponding to the injury classification code and the associated job code (Note that the invention of Iliff is replete with statistical and probability analysis capability, for example Iliff: col 22, paragraph C.; Iliff: col 60. Furthermore, the medical history would record the resolution of the problem, which would correspond to return to work. Thus group data could be calculated and averaged for return to work, and correlated to the various codes).

E. As per claim 6, Iliff discloses the case management method according to claim 4, wherein the step of identifying a well managed benchmark code includes:

estimating a period between injury and return to work corresponding to the injury classification code and the associated job code based on the provided treatment plan (rejected as per claim 5).

F. As per claim 7, Iliff discloses the case management method according to claim 4, further comprising:

estimating an estimated return-to-work date based upon the first report of injury (FROI) date and the well managed benchmark (rejected as per claim 5).

G. As per claim 8, Iliff discloses the case management method according to claim 7, wherein the step of estimating an estimated return-to-work date includes

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adding the well-managed benchmark to the FROI date (rejected as per claim 4, i.e. the well-managed benchmark and FROI dates are captured by the system, and well known mathematical operations – addition in this case - are performed as per the cited passages).

H. As per claim 9, Iliff discloses the case management method according to claim 1, wherein the step of obtaining a diagnosis includes:

receiving responses to a diagnostic questionnaire (Iliff: col 39, Ins 17); and

supplying a suggested diagnosis by comparing the responses with a preexisting diagnosis database (Iliff: col 39, Ins 18-38).

I. As per claim 10, Iliff discloses the case management method according to claim 1, further comprising:

dividing the treatment plan into treatment intervals wherein each said interval is assigned to a time block subsequent to the first report of injury (FROI) (Iliff: col 42, Ins 60-65; col 44, section ii., "Time Density". The Examiner considers the time between each consultation to be a form of treatment interval).

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J. As per claim 11, Iliff discloses the case management method according to claim 10, further comprising:

receiving updated information on the injured worker, said updated information having become available after the first report of injury (FROI) and after the obtaining of the injury diagnosis (Iliff: col 42, Ins 60-65; col 44, section ii., "Time Density", note that each consultation provides updated information on the patient);

updating a treatment interval based upon the updated information (Iliff: col 28, Ins 16-34. The Examiner considers updating the history database to be a form of updating a treatment interval); and

updating the estimated return-to-work date based upon the updated information (rejected as per claim 4).

K. As per claim 12, Iliff discloses the case management method according to claim 11, wherein the step of receiving updated information includes

receiving information from a diagnostic testing of the injured worker (Iliff: col 50, Ins 5-58).

L. As per claim 13, Iliff discloses the case management method according to claim 12, further comprising

scheduling the diagnostic testing in accordance with the treatment plan (Iliff: col 50, ln 65 to col 51, ln 7).

M. As per claim 14, Iliff discloses the case management method according to claim 12, further including

pre-certifying the diagnostic testing conditional upon the diagnostic testing being included in the treatment plan (Iliff: col 50, lns 45-52. The Examiner considers the provision of the Home Diagnostic and Treatment Kit to be a form of pre-certification of the testing. The kit is optional, see col 50, lns 15-23, and logically would not be purchased unless it was part of a treatment plan.).

N. As per claim 15, Iliff discloses the method according to claim 1, further comprising:

displaying initial case management tracking information (Iliff: col 28, lns 19-35, reads on "...summary of all the advice...");

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receiving from the user additional case management tracking information (Iliff: col 52, lns 40-54); and

appending the received additional case management tracking information to the initial case management tracking information without modifying the initial case management tracking information (Rejected for the same reasons as the previous step).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iliff (US Pat# 5,594,638, hereinafter Iliff) in view of Applicant's admitted prior art (as per the specification of the current application, hereinafter APA).

A. As per claim 3, Iliff fails to disclose the case management method according to claim 1, wherein the step of receiving an associated job code includes

receiving an associated NCCI job code.

However, this feature is well known in the art as evidenced by Applicant's admitted prior art.

APA discloses the use of an NCCI job classification to calculate an expected return-to-work date for a patient (APA: pg. 2, lns 13-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the disclosure of Applicant's admitted prior art with the teachings of Iliff, with the motivation of providing an additional system to characterize a patient's situation, namely, the patient's occupation.

7. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iliff in view of Applicant's admitted prior art (Healthcare Financial Management; July 1999; v. 53, iss. 7, pg. 22; hereinafter Healthcare Financial Management).

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A. As per claim 16, Iliff fails to explicitly disclose the method according to claim 15, wherein the step of displaying case management tracking information includes

displaying URAC-compliance case management tracking information.

However, this feature is well known in the art as evidenced by the teachings of Healthcare Financial Management.

Healthcare Financial Management discloses the release of URAC case management standards for organizations that provide services by telephone.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the disclosure of Healthcare Financial Management within the method of Iliff with the motivation of providing standards for patient confidentiality, informed consent, and ethics (Healthcare Financial Management, entire passage).

B. As per claim 17, Iliff discloses the method according to claim 16, further comprising:

setting a compliance flag conditional upon meeting a pre-selected set of conditions indicating compliance (for example Iliff: col 27-42, where the flag associated with the condition for the patient to "re-enter" is pre-selected).

Iliff fails to explicitly disclose

setting a URAC compliance flag conditional upon meeting a pre-selected set of conditions indicating compliance with URAC standards.

However, this feature is well known in the art as evidenced by the teachings of Healthcare Financial Management.

Healthcare Financial Management discloses the release of URAC case management standards for organizations that provide services by telephone.

The motivation to combine the teachings of Healthcare Financial Management and Iliff are as provided as provided above for claim 16 and are incorporated within.

8. As per claims 18-27, they are system claims which repeat the same limitations of claims 1-8, the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of Iliff disclose the underlying process steps that constitute the methods of claims 1-8, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 18-27 are rejected for the same reasons given above for claims 1-8.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art discloses a complete system for personal injury claims management; an expert system for providing medical

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treatment; and an all purpose system and method for managing healthcare-related information (US Pat#s 5,956,687; 5,517,405; 6,283,761 respectively).

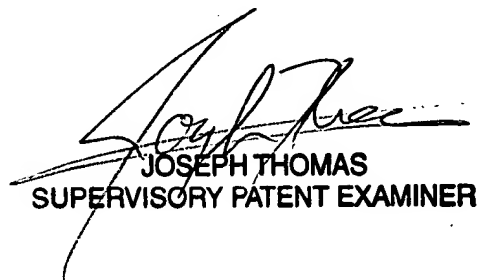
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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